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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,739	07/31/2001	William J. Egan	PHARMA.003A	3949

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/919,739

Applicant(s)

EGAN ET AL.

Examiner

Carolyn L Smith

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3,4 and 6-8.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Some of the claim amendments (i.e. "first subset") appear to be NEW MATTER. In addition, the amendments raise new issues that would require further consideration and search.

Continuation of 5. does NOT place the application in condition for allowance because: it raises NEW MATTER issues and new issues requiring further consideration and search. Because of these issues, the proposed amendment will not be entered and all rejections are maintained. If the proposed amendment had been entered, the 35 USC 101 rejection, the 35 USC 112, 1<sup>st</sup> NEW MATTER rejection (regarding "numerical similarity") and some of the 35 USC 112, 2<sup>nd</sup> paragraph rejections (regarding "said set", "for each other molecule in said set", and "said number of molecules") would have been removed. However, the 35 USC 112, 1<sup>st</sup> NEW MATTER rejection (regarding the sorting step) and the 35 USC 112, second paragraph rejections (regarding "each other's molecule" in claim 3, now line 16 and "a fractions-correctly-predicted metric..." in claim 3, now lines 11-17) would have been maintained.

**Rejections under 35 USC 112, 1<sup>st</sup> paragraph NEW MATTER**

Applicants state that the specification does not mention that the sorting step was essential or a critical feature of the invention, such that its removal in claim amendments should not be considered to be NEW MATTER. This statement is found unpersuasive as it does not appear that the specification recites that the instant method has an and/or reference regarding this sorting step. Instead, the sorting step appears to always be present in the description of the instant invention. Applicants refer to Figure 2. It is noted that in the flow chart of Figure 2, one must always pass through the sorting step to complete the sequence of events. Applicants refer to Figure 1. It is noted that this flowchart is not a valid reference guide to the steps of the instant invention, as it only mentions a portion of the claimed invention (only some of the first mentioned steps). Where the instant invention has been described in detail, the sorting step is always present.

**Rejections under 35 USC 112, 2<sup>nd</sup> paragraph rejections**

Applicants mention attempting to clarify "subset" with the phrase "first subset"; however, this phrase appears to be NEW MATTER. In the proposed amendments, Applicants have not amended "each other's molecule" on proposed line 16 of claim 3 which leads to a vague and indefinite rejection to remain for the phrase itself as well as the "a fractions-correctly-predicted metric..." rejection.

*Ardin H. Marschel* 1/30/05  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER